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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,522	05/25/2005	Christoph Voss	PC10591US	9442
23122	7590	12/22/2006	EXAMINER	
RATNERPRESTIA P O BOX 980 VALLEY FORGE, PA 19482-0980			LEE, CLOUD K	
			ART UNIT	PAPER NUMBER
			3753	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/22/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/536,522	VOSS, CHRISTOPH	
	Examiner Cloud K. Lee	Art Unit 3753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 May 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 18-34 is/are pending in the application.
- 4a) Of the above claim(s) 28-34 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 18-27 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 May 2005 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/25/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Species A is defined as Figures 1-2.

Species B is defined as Figures 3-4.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

Claims 18-27 are drawn to Species A.

Claims 18, 28-34 are drawn to Species B.

The following claim(s) are generic: Claim 18 is generic.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. In the instant application, the only corresponding features are those recited in claim 18, which does not define a contribution over the prior art as evidenced by Wilde et al. and Breyer et al.

During a telephone conversation with Attorney Seitter, Robert on 11/30/06 a provisional election was made without traverse to prosecute the invention of Species A, claims 18-27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 28-34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Wilde et al (WO 02/12037 A1).

Wilde et al disclose a valve housing accommodating an armature (23), a magnet core part (22), a valve closure (25), a valve seat (37), the housing being formed of a first (35) and a second (21) tubular body, said two tubular bodies with their ends being joined in sections in each other (31) and including a joining portion, a valve –accommodating member (see figure 1) into which the section of the first tubular body remote from the second tubular body is inserted in a pressure-fluid tight manner (see Description of the embodiment), the section of the second tubular body remote from the first tubular body carrying a magnet coil (17) outside the valve-accommodating member, wherein the section of the second tubular body facing the first tubular body is secured to the valve-accommodating member, and in that the section of the first tubular body facing the second tubular body is inserted into the second tubular body and directed to a stop surface (44) of the second tubular body, wherein the first tubular body is supported with its end remote from the joining portion in a stepped bore of the valve accommodating member in a pressure-fluid tight manner (see figures 1 and 2), with the axial distance between the first tubular body and a bottom of the stepped bore being smaller than the length of the overlapping of both tubular bodies in the area of the joining portion (see figure 1), wherein the housing step, for the assembly and calking (52) of the second tubular body in the valve-accommodating member, receive a hollow-cylindrical calking tool that is supported with its inside shoulder on the housing

step, wherein the outside periphery of the calking tool is provided with two housing steps adjacent to which is a conical portion in the direction of the plan outside shoulder.

4. Claims 18 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Breyer et al (US Patent No. 6,530,528).

Breyer et al disclose a valve housing accommodating an armature (66), a magnet core part (64), a valve closure (25), a valve seat (26), the housing being formed of a first (45) and a second (24) tubular body, said two tubular bodies with their ends being joined in sections in each other (see figure 2) and including a joining portion, a valve -accommodating member (see figure 1) into which the section of the first tubular body remote from the second tubular body is inserted in a pressure-fluid tight manner , the section of the second tubular body remote from the first tubular body carrying a magnet coil (88) outside the valve-accommodating member, wherein the section of the second tubular body facing the first tubular body is secured to the valve-accommodating member, and in that the section of the first tubular body facing the second tubular body is inserted into the second tubular body and directed to a stop surface (50) of the second tubular body, wherein the end of the second tubular body facing the valve-accommodating member includes a bead that is directed radially outwards (52) and fastened in a stepped bore of the valve accommodating member (see figure 1).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 21-27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wilde et al (WO 02/12037 A1).

The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process (see MPEP 2113).

7. Claims 20-27 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Breyer et al (US Patent No. 6,530,528).

The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product was made by a different process (see MPEP 2113).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mayer (US Patent No. 6,637,724) and Zutt et al (US Patent No. 6,851,659) disclose a similar device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cloud K. Lee whose telephone number is (571)272-7206. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Keasel can be reached on (571)272-4929. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CL



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